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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,321	12/23/2003	Peter Elms	86769-0026 US	5565
30398	7590	08/08/2008		
ACCENTURE, LLP C/O HOGAN & HARTSON, LLP (IPGROUP) 555 13TH STREET NW, SUITE 600E WASHINGTON, DC 20004			EXAMINER PARTHASARATHY, PRAMILA	
			ART UNIT 2136	PAPER NUMBER
			NOTIFICATION DATE 08/08/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

deftpntent@hhlaw.com

### Office Action Summary

**Application No.**

10/743,321

**Applicant(s)**

ELMS ET AL.

**Examiner**

PRAMILA PARTHASARATHY

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 14, 19-23 and 31-41 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18, 24-30 and 42 is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to the communication filed on 5/07/2008. In response to the office action mailed on 8/15/2007, Claims were amended. New claim 42 has been added. Claims 1 – 13, 15 – 18, 24 – 30 and 42 are currently pending.

### ***Response to Arguments***

2. With respect to obviousness-type double patenting, Applicant's arguments have been fully considered and are persuasive as claims of copending applications 11/176,681 and 11/176,682 have not been allowed. However, with respect to copending application 11/176,685, they are not persuasive. Examiner directs applicant's attention to item#4 for an exemplary mapping of claim limitations from the instant applications.

With respect to prior art rejection, Applicant's arguments are persuasive with respect to Claim 18 and Examiner withdraws prior art rejection. However, as per Applicant's generalization of claim 1 reciting similar features as 18, Examiner disagrees and directs to prior art rejection for Claim 1 and maintains previous rejection. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Examiner further suggests applicant to amend the claims in a manner to distinct applicant's invention with prior art with **attention** given to the specification page (for example, explaining/detailing the limitation "dual login"). Dependent claims are rejection at least by the virtue of their dependencies on the rejected Claim 1.

Arguments With respect to newly introduced limitations of Claim 42 (filed on 5/7/2008), Examiner agrees that prior art does not suggest/explain that "the dual login features" as a significant added level of additional security of the system, as detailed in the claim limitations.

***Allowable Subject Matter***

3. Claims 18, 24 – 30 and 42 are allowed.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 – 18, 24 – 30 and 42 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 30 of U.S. copending application No. 11/176,685. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant case, all elements of instant claims correspond to the claims of the copending claims and copending claims encompass the scope of claims of the instant application.

The instant application generally claims a method for registering a user to vote with the user's local election office through a secure electronic registration and voting system, comprising the steps of logging into the secure electronic registration and voting system by the

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user. Copending application 11/176,685 claims similar limitations with "a method for identifying and authenticating a user through a secure electronic registration and voting system comprising the steps of: providing a computer to a user; the computer signing a completed electronic application with a digital signature assigned to the user", which is equivalent to the instant application "signing the completed electronic application with a digital signature assigned to the user" and "...the identification and authentication process element further comprises: ... roaming digital certificate and managed public key infrastructure services". A partial correspondence between the instant claims and the copending claims are as follows:

10/743,321	11/176,685
<p>A secure electronic registration and voting system providing access to voting related and processes through a network, the secure electronic registration and voting system comprising:</p> <ul style="list-style-type: none"> <li>a central hosting facility, including a system web server for housing a home page and web pages, a data storage device for storing local election office data, and an application processing segment providing the voting related subsystems and processes, the application processing segment further including:</li> <li>an identification and authentication subsystem and associated services for identity proofing and assigning a roaming digital certificate to users and local election officials by the user or local election official submitting an approved credential or retrieving, completing, and submitting an identity proofing form,</li> <li>a voter registration subsystem and associated processes for registering a user to vote by completing an electronic application, digitally signing the application with the assigned roaming digital certificate, and having the application submitted electronically, wherein a local election official may review the application, approve or deny the application, update the status of the application, and communicate the status of the application to</li> </ul>	<p>A secure electronic registration and voting system providing access to voting related and processes through a network, the secure electronic registration and voting system comprising:</p> <ul style="list-style-type: none"> <li>a central hosting facility, including a system web server for housing a home page and web pages, a data storage device for storing local election office data, and an application processing segment providing the voting related subsystems and processes, the application processing segment further including:</li> <li>an identification and authentication subsystem and associated services for identity proofing and assigning a roaming digital certificate to users and local election officials by the user or local election official submitting an approved credential or retrieving, completing, and submitting an identity proofing form,</li> <li>a voter registration subsystem and associated processes for registering a user to vote by completing an electronic application, digitally signing the application with the assigned roaming digital certificate, and having the application submitted electronically, wherein a local election official may review the application, approve or deny the application, update the status of the application, and communicate the status of the application to</li> </ul>

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the user, a ballot creation subsystem and associated processes for creating a ballot definition file by an official of the local election office, transforming the ballot definition file to a standard format, validating the ballot by the local election official, and providing the ballot for use by the user, a voting subsystem and associated processes for providing secure voting by identifying and authenticating a user that logs in to vote and request a ballot, retrieving the user's identification information and digital certificate, generating a ballot from the user's local election office ballot definition file, digitally signing the ballot, sending the ballot to the user, receiving from the user the completed ballot digitally signed with the user's roaming digital certificate, time stamping the ballot, encrypting the ballot with a user's symmetric key, and storing the encrypted ballot, transmitting a ballot summary to the user for confirmation, receiving confirmation, time stamping the ballot and encrypting the user's symmetric key with a local election office's public key, and storing the encrypted symmetric key and associated encrypted ballot in the local election office's electronic ballot box, ballot tabulation and reconciliation subsystem and associated processes for reconciling encrypted ballots, wherein ballot tabulation includes providing a local election office with a token and a tabulation computer and requiring one election official to login to the tabulation computer and a second election official to login to the central hosting facility, separating voter identification information from the encrypted ballots and transferring the encrypted ballots to the tabulation computer, decrypting the ballots by decrypting the symmetric key associated with each ballot with the local election office's public key and decrypting each ballot with its associated symmetric key, and tabulating the decrypted ballots, and a common services subsystem and associated processes; a computer device for

the user, a ballot creation subsystem and associated processes for creating a ballot definition file by an official of the local election office, transforming the ballot definition file to a standard format, validating the ballot by the local election official, and providing the ballot for use by the user, a voting subsystem and associated processes for providing secure voting by identifying and authenticating a user that logs in to vote and request a ballot, retrieving the user's identification information and digital certificate, generating a ballot from the user's local election office ballot definition file, digitally signing the ballot, sending the ballot to the user, receiving from the user the completed ballot digitally signed with the user's roaming digital certificate, time stamping the ballot, encrypting the ballot with a user's symmetric key, and storing the encrypted ballot, transmitting a ballot summary to the user for confirmation, receiving confirmation, time stamping the ballot and encrypting the user's symmetric key with a local election office's public key, and storing the encrypted symmetric key and associated encrypted ballot in the local election office's electronic ballot box, ballot tabulation and reconciliation subsystem and associated processes for reconciling encrypted ballots, wherein ballot tabulation includes providing a local election office with a token and a tabulation computer and requiring one election official to login to the tabulation computer and a second election official to login to the central hosting facility, separating voter identification information from the encrypted ballots and transferring the encrypted ballots to the tabulation computer, decrypting the ballots by decrypting the symmetric key associated with each ballot with the local election office's public key and decrypting each ballot with its associated symmetric key, and tabulating the decrypted ballots, and a common services subsystem and associated processes; a computer device for

accessing the central hosting facility through the network	accessing the central hosting facility through the network
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Copending application further recites " an application residing on said computing device, wherein said computing device application presents an electronic ballot to a user and said computing device application forwards voting data to the central hosting facility in an encrypted format, said voting data comprising a user identifier, an computing device identifier, and ballot data corresponding to ballot selections by the user, and wherein said central hosting facility receives and authenticates the voting data using the user identifier and the computing device identifier, and the central hosting facility stores the encrypted voting data without decrypting the ballot data", which is fully disclosed in the instant specification and encompass the copending claim.

Claims of the instant application are anticipated by patent claims in that the patent claims contains all the limitations of the instant application. Claims of the instant application therefore is not patentably distinct from the earlier patent claims and as such are unpatentable for obvious-type double patenting (*In re Goodman (CAFC) 29 USPQ2d 2010 (12/3/1993)*).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1 – 10 and 12 – 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Rodriguez et al. (U.S. Publication Number 2002/0138341).

6 As per Claim 1, Rodriguez teaches “a central hosting facility connected to the network, the central hosting facility including a home page as an access point, an application processing segment for providing election comprising:

dual login and ballot decryption services, and a storage segment for temporary and persistent storage of data; and a computing device connected to the network for accessing the central hosting facility” (summary and paragraph [0025 – 0058]);

Rodriguez discloses a network system that includes a Transaction Repository server site , a Transaction mediator server site (authenticates identities using cryptographic information transmitted between the first computer and TR server; verifies digital signatures and validates cryptographic identification of citizens (votes, users); maintains electronic registration forms) connected over an electronic communications network such as, for example, the Internet.

7. As per dependent Claims, Rodriguez discloses a network system that includes a Transaction Repository server site , a Transaction mediator server site (authenticates identities using cryptographic information transmitted between the first computer and TR server; verifies digital signatures and validates cryptographic identification of citizens (votes, users); maintains electronic registration forms) connected over an electronic communications network such as, for example, the Internet. The user transmits registration information from the first computer to a database that resides on a TR server, the information can include either the descriptive elements or electronic registration form. The registration information and the form are digitally signed, the identification tag of the appropriate TR server is attached to the information. The server verifies the digital signature of the registration information and validity of the



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cryptographic identification (created and issued by TR server). The TR server verifies and confirms the validity of the user to the TM server and upon request by the registered voter (user), if the user is eligible to vote, an electronic ballot (which can have a digital certificate) is transmitted to the user. The user supplies the necessary information on the ballot and digitally signs (symmetric key) the ballot before transmitting to the TM server. TM server can attach a date-time stamp to the voted electronic ballot and sends it to the TR server where each electronic ballot is processed and tallied.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRAMILA PARTHASARATHY whose telephone number is (571)272-3866. The examiner can normally be reached on 8:00a.m. to 5:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pramila Parthasarathy/  
Primary Examiner, Art Unit 2136  
July 29, 2008.